

REMARKS

A new deceleration is attached in response to Examiner's comments in section 2 of the Office Action.

The Applicant makes the following remarks in response to the Examiner's comments as to the Information Disclosure Statement filed on January 30, 2004. A copy of the postcard receipt for the Information Disclosure Statement is enclosed, which shows that the four cited references were received at the PTO. Copies of those references and a copy of the Information Disclosure Statement are attached to this amendment.

The EPO search report was submitted with the explanation of relevance in that it listed the references cited by the EPO Examiner. This list has the EPO Examiner's ranking of relevance of the cited references which may be deemed important information. The procedures of 35 CFR § 1.97 & 1.98 were complied with and it is requested that the Information Disclosure Statement of January 30, 2004 be considered.

In response to cited objections to the claims, Applicant has amended claim 1 at line 1, to add a recitation that the composition is free of nitrates. Additionally a fuller description of the base oil was also added to the claim beginning in line 6. The diurea compound recitation element, at line 9, was also expanded to include formula (2) and a description therein. These additions constitute the disclosures of claims 2 and 4-6.

Applicant has canceled claims 2 and 4-6. Applicant has amended claims 3 and 7-12. Specifically, in claims 3, 7-12 the term "A" was replaced with "The" thereby allowing the claims to properly refer back to claim 1. The cancellation of claim 2 has rendered moot the rejection under 35 U.S.C. § 112, second paragraph.

Applicant has amended the specification in the a manner suggested by the Examiner. Specifically the Title was amended to cure lack of descriptiveness. Additionally, a new Abstract has been provided that is in accordance with the guidelines of MPEP 608.01(b). Finally, in "the detailed description of the preferred embodiment" section, beginning on page 6, page 17, lines 1-7 were amended to correct typographical errors, i.e. changing the term "2a" to "3a" and the term "inner" to "outer".

In the Office Action, the Examiner rejected claims 1, 5, and 8-12 under 35 U.S.C. 102(b) as being anticipated by Japanese Publication No. 11-256184(herein JP11). As a result, Applicants have amended claims 1, and 8-12 and canceled claims 2 and 4-6. It is the Applicant's position that the cited reference does not disclose or suggest the usage of aliphatic hydrocarbon. Amended claim 1 now contains a recitation stating that the sub groups of the salt can be either aromatic or aliphatic hydrocarbons. Claim 1 also recites a grease composition that lacks nitrates. The cited reference does not disclose the features of the present invention. For a reference to anticipate the present invention, the reference must disclose all the elements and limitations disclosed by the present invention. As demonstrated above, the cited reference fails to disclose critical elements. Applicants request that the 102(b) basis for rejection be removed and the claims be put in a condition for allowance.

In the Office Action, the Examiner rejected claims 1, 5, and 8-12 under 35 U.S.C. 103(a) as being unpatentable over Japanese Publication Number 11-256184 (JP11) in view of Merker, U.S. Patent No. 2,722,516(herein '516). In order to sustain a finding of obviousness, any combination of the prior art must be supported by a suggestion, teaching or motivation found in the prior art or in the general knowledge of those skilled in the art. Additionally, the scope and content of the prior art must be taken into account. In this instance, the prior art does not achieve the same scope and content of the present invention. As stated previously, the JP11 reference fails to disclose aliphatic hydrocarbon groups. The '516 reference does not disclose a combination of an alkylidiphenyl ether oil as a base oil and an aromatic diurea compound as a thickener. There is no motivation to combine these references other than the suggestion of the Examiner. The references themselves do not disclose the necessity or desirability of including the missing elements. JP11 specifically states a different type of dibasic acid than one that can be used by the present invention. As such, any resulting combination would teach away from the present invention. See comparative example 1. Applicant respectfully request that the rejection based on 103(a) be removed on the basis that there is no motivation or suggestion to combine the cited references.

In the Office Action the Examiner rejected claims 2-4, 6, 7, and 13 under 35 U.S.C. 103(a) as being unpatentable over Idemitsu in view of Merker as applied to claims 1, 5, and 8-12 above, and in further view of Yokouchi et al., U.S. Patent No. 5,840,666(herein '666). The Applicant has canceled claims 2-4, and 6. The rejection therefore only applies to claims

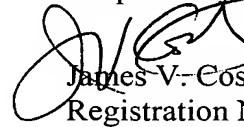
7 and 13. It is Applicants position that the cited reference does not disclose the same type of thickener. The present invention solely uses an aromatic diurea compound. The prior art uses this compound and other additives as a thickener. The Examiner has not stated why it would have been obvious to combine the references and then delete chemical compounds in the resulting combination. Consequently, the resulting combination of the prior art is not the same as the present invention, and as such can not be considered obvious. Additionally, the Examiner has not shown where the motivation to combine the references originates. The Examiner cites claim 13 as obvious in light of the prior art references. Ball bearings are extremely well known in the art, what is being claimed is the grease composition used in conjunction with the ball bearing. Through the arguments above, Applicant has demonstrated that the composition is not obvious, as such claim 13 can not be obvious.

In all, none of the prior art references disclosed the necessity for the resulting grease composition to be nitrate free. A nitrate free composition is more economical and safer when it is disposed. The nitrate free composition also provides a compatible level of performance when compared to other more nitrate containing substances in terms of life span and rust preventative properties.

Conclusion

Based on the foregoing amendments and remarks Applicant believes this reply to overcome the rejections and objections listed in the Office Action dated November 3, 2005. An early and favorable action is earnestly solicited.

Respectfully Submitted,


James V. Costigan
Registration No. :25,669

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, N.Y. 10036-2646
(212) 302-8989

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450 on 2/3/06

